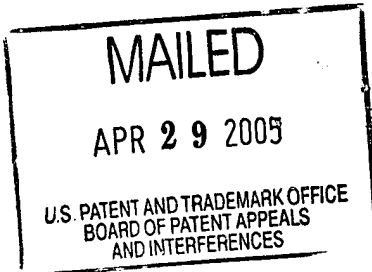


The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES F. MCGUCKIN JR.

Appeal No. 2005-1027
Application No. 09/697,306

ON BRIEF

Before KIMLIN, GARRIS and WALTZ, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner for consideration of arguments presented by appellant in the Reply Brief of November 4, 2004. In particular, the examiner should issue a Supplemental Answer that addresses the arguments set forth at pages 4 and 5 of the Reply Brief with respect to the rejection under 35 U.S.C. § 102(e) over Kuramoto. Appellant maintains that the holding forceps 150 of Kuramoto are used only to manipulate and hold the tip of the anvil shaft and are incompatible with the function of drawing tissue between the

anvil and the stapling mechanism. In contesting the examiner's position that "the forceps could easily grasp tissue present anywhere between [housing] 138 and [anvil] 146" (page 4 of Answer), appellant explains that "[e]ven assuming for the sake of argument that the holding forceps 150 could grab tissue, simply grabbing tissue would completely frustrate the purpose of the stapler/endoscope in Kuramoto" (page 4 of Reply Brief, second paragraph). Appellant explains that "if . . . the holding forceps 150 were to be used to grab tissue and pull that tissue toward the housing 138, no stapling operation could be performed by the device as no anvil would be present to hold the tissue and form the staples 35" (id.).

Also, regarding the examiner's position pertaining to the cutting zone of Kuramoto, appellant contends that "Kuramoto only contemplates the cutting zone being the area of tissue to be excised, which is between the housing 138 and the anvil 146, after the anvil 146 has been coupled to the housing 138" (page 5 of Reply Brief, second paragraph).

In addition to providing a response to appellant's arguments regarding the § 102 rejection, the examiner may include in the Supplemental Answer responses to any arguments of appellant

Appeal No. 2005-1027
Application No. 09/697,306

concerning the § 103 rejection of claims 36-48 (see Reply Brief at pages 6-12).

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMAND


EDWARD C. KIMLIN
Administrative Patent Judge


BRADLEY R. GARRISS
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

THOMAS A. WALTZ
Administrative Patent Judge

ECK:clm

Appeal No. 2005-1027
Application No. 09/697,306

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038